REMARKS

The August 20, 2008 Office Action was based upon pending Claims 1-3, 5-9, 11, 13-16 and 21-28. This Amendment amends Claims 1, 3, 5-8, 13-16, 21, 23, and 24 and cancels Claims 25-28. Thus, after entry of this Amendment, Claims 1-3, 5-9, 11, 13-16 and 21-24 are pending and presented for further consideration.

ISSUES RAISED IN THE OFFICE ACTION

The Office Action rejected Claims 1-3, 5-9, 11, 13-16 and 21-28 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Further, the Office Action rejected Claims 1-3, 5-9, 11, 13-16 and 21-28 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,668,857 to McHale (hereinafter "McHale"), in view of U.S. Patent No. 6,795,408 to Hiett (hereinafter "Hiett").

REJECTION OF CLAIMS 1-3, 5-9, 11, 13-16 AND 21-28 UNDER 35 U.S.C. § 112

The Office Action rejected Claims 1-3, 5-9, 11, 13-16 and 21-28 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. In particular, the Office Action rejected the language associated with determining whether a modem was active. The Examiner, however, did state that there was support for determining whether a modem is inactive.

While Applicant disagrees with the Examiner's conclusions regarding written description support, Applicant has amended the claims to focus on determining whether a modem is inactive. Applicant therefore respectfully submits that the claims now fully comply with the written description requirement.

REJECTION OF CLAIMS 1-3, 5-9, 11, 13-16 AND 21-28 UNDER 35 U.S.C. §103(a)

The Office Action rejected Claims 1-3, 5-9, 11, 13-16 and 21-28 under 35 U.S.C. §103(a) as being unpatentable over McHale, in view of Hiett. Applicant has made a number of amendments to the claims and thus, for convenience, Applicant has attached hereto a clean copy of the claims as Exhibit A.

Claim 1

Claim 1 is directed to an Internet service provider that also provides facsimile services on inactive modems.

A.   Providing Internet Access Services And Facsimile Services

In particular, Claim 1 is directed to a method of communicating a message via a computer network, the method comprising: providing internet access services to a plurality of subscribers with a target server by receiving with a plurality of modems connected to the target server a plurality of in-bound requests from the subscribers for access to the Internet.

This target server is located within a same local-toll area of a public switched telephone network as a target transceiver. Furthermore, the target transceiver is different than the subscribers sending in-bound requests to the target server.

None of the cited references, in contrast, describe an Internet service provider that sends a facsimile message to a target transceiver in the same area code as the Internet service provider. Still further, none of the cited references describe, teach or suggest sending a message to a target transceiver that is different than the subscribers of the Internet service provider.

B.   Transmitting Facsimile Messages With Inactive Modems

The method further comprises receiving at the target server via the Internet a message from a sending server wherein the message is directed to the target transceiver.

This message is to be sent as outbound facsimile transmissions from the target server to the target transceiver. In addition, the message is sent with the modems that receive the in-bound requests for access to the Internet from the subscribers. These modems are further configured to transmit the message as a facsimile transmission from the target server to the target transceiver via the public switched telephone network.

The method also comprises determining with a processor whether one or more modem ports at the target server is inactive such that at least one of the modem ports is not in communication with one or more of the subscribers.

Furthermore, the method sends the message as an outgoing facsimile transmission via an available modem and the public switched telephone network to the target transceiver if one of the modem ports is inactive.

None of the cited references, however, describe an Internet access provider that uses inactive modems to send a message to a target transceiver. Still further, none of the cited references describe, teach or suggest sending a _facsimile_ message to a target transceiver with an _inactive_ Internet access modem.

C.   A Variable Wait Time When None Of The Modems Are Inactive

If none of the modem ports are inactive, applying a variable wait time. This wait time is unique in that the duration of the variable wait time is applied based at least in part on historical data, based at least in part on the number of modems, and based at least in part on the number of subscribers.

After the variable wait time, the method determines with a processor whether one or more of the modem ports is inactive.

Unlike Claim 1, the cited references fail to describe a variable wait to time for the sending of an _outgoing_ facsimile based at least in part on the number of subscribers that send _in-bound_ requests to access the Internet. Still further, none of the cited references describe, teach or suggest a variable wait time for sending a facsimile based on historical data.

D.   Sending Confirmation from the Target Server

The method further sends a confirmation from the target server to the sending server confirming the sending of the message as a facsimile transmission to the target transceiver.

None of the cited references, in contrast, describe such a claimed system that also then sends a facsimile confirmation from the target server to the sending server.

Improper Finding of Obviousness

KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727, 82 U.S.P.Q.2d 1385 (2007), in no way relieves the Patent Office of its obligation to "consider *all claim limitations* when determining patentability of an invention over the prior art." Accordingly, it remains well settled law that a finding of "obviousness requires a suggestion of *all limitations* in a claim." CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003) (emphasis added) (cited in Ex Parte Wada, 2008 WL 142652, *4 (Bd.Pat.App. & Interf., Jan. 14, 2008)).

In the aftermath of KSR, the Board of Patent Appeals and Interferences has repeatedly reversed findings of obviousness when the Examiner has failed to proffer a prima facie case of obviousness. See, e.g., Wada, 2008 WL 142652 at *5 ("Because the Examiner has not explained why *every limitation* in claim 1 would have been obvious to a person of ordinary skill in the art, we agree with Appellants that the Examiner has not made out a case of prima facie obviousness.") (emphasis added); Ex Parte Challapali, 2008 WL 111346, *4-6 (Bd.Pat.App. & Interf., Jan. 10, 2008) (reversing finding of obviousness because the Examiner failed to establish sufficient reasoning for combining the references).

The Examiner Has Not Presented a Prima Facie Case of Obviousness

In view of the significant differences between the cited references and Claim1, Applicant submits that Claim 1 is patentable over the cited references because the cited reference do not teach every element of Claim 1. In particular, the cited references fail to teach a number of the elements including:

1) sending with an Internet access provider, a facsimile message to a target transceiver;

2) sending a message to a target transceiver that is different than the subscribers of the Internet service provider;

3) sending as outbound facsimile transmission with the modems that receive in-bound requests for access to the Internet from the subscribers; and

4) still further, none of the cited references describe, teach or suggest sending a facsimile message to a target transceiver with an inactive Internet access modem.

Thus, in order to establish a prima facie case of obviousness for the pending claims, the Examiner must present, inter alia, references that when combined have each and every claim limitation. However, neither of the combined references suggests such limitations.

Indeed, even when the cited references are combined, they do not teach _all_ the elements of Claim 1. Applicant therefore respectfully submits that Claim 1 is patentably distinguished over the cited references and Applicant respectfully requests allowance of Claim 1.

Claims 2, 4, 5-9, and 11

Claims 2, 4, 5-9, and 11 depend from Claim 1 and are believed to be patentable for the same reasons articulated above with respect to Claim 1, and because of the additional features recited therein.

Claim 13

Claim 13 is directed to a system for communicating a message via a computer network, the system comprising a target server that provides Internet access services to a plurality of subscribers.

The target server is in communication with a plurality of modems that receive in-bound requests from the subscribers for internet access services. In addition, the target server and a target transceiver are located within a same local-toll area of a public switched telephone network connected to the target server and the target transceiver.

The target server is also configured to receive a message from a sending server via the Internet wherein the target server is further configured send the message as an outgoing facsimile transmission to the target transceiver via the public switched telephone network.

In addition, the target server determines whether one or more of the modems in communication with the target server is inactive, such that one or more of the modems are not in communication with one or more of the subscribers;

Furthermore, the target server is configured to apply a variable wait time when the one or more of the modems are not inactive, wherein a determined duration of the variable wait time is variably applied based at least in part on historical data and based at least in part on the utilization of the modems;

The target server is also configured to determine whether at least one of the modems is inactive after the variable wait time. In addition, the target server is configured to send the message as an outgoing facsimile transmission to the target transceiver via the modem and the public switched telephone network.

Applicant therefore respectfully submits that Claim 13 is patentably distinguished over the cited references and Applicant respectfully requests allowance of Claim 13.

Claims 14-16

Claims 14-16 depend from Claim 13 and are believed to be patentable for the same reasons articulated above with respect to Claim 13, and because of the additional features recited therein.

Claim 21

Claim 21 is directed to a method of communicating a message via a computer network, the method comprising receiving a message from a transceiver and a first server at a second server such that a second transceiver and the second server are located within a same local-toll area of a public switched telephone network and wherein the public switched telephone network is connected to the second server and to the second transceiver.

The method also comprises providing internet access services with the second server to a plurality of subscribers with a plurality of modems connected to the target server, wherein the modems receive a plurality of in-bound requests from the

subscribers for access to the Internet and wherein the modems are configured to communicate the message to recipients via the public switched telephone network.

In addition, the method comprises receiving and storing the message at the second server and determining whether one or more of the modems are inactive such that at least one of the modems is not in communication with one or more of the subscribers.

Furthermore, the method comprises determining and applying a variable wait time when modems are not inactive, wherein the duration of the variable wait time is applied based at least in part on historical data and based at least in part on a number of the modems.

The method also comprises determining availability of the modems after the variable wait time; and if one of the modems is available after the variable wait time, sending the message via an available one of the modems and the public switched telephone network to the second transceiver.

Applicant therefore respectfully submits that Claim 21 is patentably distinguished over the cited references and Applicant respectfully requests allowance of Claim 21.

<u>Claims 22-24</u>

Claims 22-24 depend from Claim 21 and are believed to be patentable for the same reasons articulated above with respect to Claim 21, and because of the additional features recited therein.

<u>No Disclaimers or Disavowals</u>

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application.

Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution.

Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

CO-PENDING APPLICATIONS OF ASSIGNEE

Applicant wishes to draw the Examiner's attention that co-pending Application No. 11/496,705 claims priority to the present application.   Applicant notes that a recent Office Action was received for this co-pending application.

Applicant also understands that the Examiner has access to sophisticated online Patent Office computing systems that provide ready access to, for example, the specification and drawing publications, pending claims and complete file histories, including, for example, cited art, office actions, responses, and notices of allowance.

However, if the Examiner cannot readily access the file history of this co-pending application, the Applicant would be pleased to provide any portion of any of the file histories at any time upon specific Examiner request.

CONCLUSION

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action.   In light of the above remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Exhibit A – Clean Copy of Pending Claims

1.   A method of communicating a message via a computer network, the method comprising:

> providing internet access services to a plurality of subscribers with a target server by receiving with a plurality of modems connected to the target server a plurality of in-bound requests from the subscribers for access to the Internet, wherein the target server is located within a same local-toll area of a public switched telephone network as a target transceiver, and wherein the target transceiver is different than the subscribers sending in-bound requests to the target server;

> receiving at the target server via the Internet a message from a sending server wherein the message is directed to the target transceiver, and wherein the messages are to be sent as outbound facsimile transmissions from the target server to the target transceiver, and wherein the modems that receive the in-bound requests for access to the Internet from the subscribers are further configured to transmit the message as a facsimile transmission from the target server to the target transceiver via the public switched telephone network;

> determining with a processor whether one or more modem ports at the target server is inactive such that at least one of the modem ports is not receiving in-bound requests for Internet access from one or more of the subscribers;

> if none of the modem ports are inactive, applying a variable wait time, wherein a duration of the variable wait time is applied based at least in part on historical data, based at least in part on the number of modems, and based at least in part on the number of subscribers;

> after the variable wait time, determining with a processor whether one or more of the modem ports is inactive;

sending the message as an outgoing facsimile transmission via an available modem and the public switched telephone network to the target transceiver if at least one of the modem ports is inactive;

and sending a confirmation from the target server to the sending server confirming the sending of the message as a facsimile transmission to the target transceiver.

2.   The method of Claim 1, further comprising storing the message at the target server.

3.   The method of Claim 1, further comprising reserving an available modem for transmitting the message to the target transceiver.

4.   (Canceled)

5.   The method of Claim 1, wherein determining whether one or more of the modem ports is inactive is performed periodically at predetermined times, or at start-up of the target server, or after one of the modems is removed or another of the modems is added.

6.   The method of Claim 1, further comprising saving an active state of one or more of the modems in a memory.

7.   The method of Claim 1, further comprising queuing the message for sending at a later time if there is no modem available for immediate sending.

8.   The method of Claim 1, wherein the variable waits time is based upon at least one characteristic of the load upon the modems.

9.   The method of Claim 1, further comprising sending a transmittal report to a transceiver having originated the message.

10.   (Canceled)

11.   The method of Claim 1, further comprising receiving the message, wherein receiving the message includes handling the message according to the T.37 standard.

12. (Canceled)

13. A system for communicating a message via a computer network, the system comprising:

a target server that provides Internet access services to a plurality of subscribers, wherein the target server is in communication with a plurality of modems that receive in-bound requests from the subscribers for internet access services and wherein the target server and a target transceiver are located within a same local-toll area of a public switched telephone network connected to the target server and the target transceiver;

wherein the target server is configured to receive a message from a sending server via the Internet wherein the target server is further configured send the message as an outgoing facsimile transmission to the target transceiver via the public switched telephone network;

wherein the target server determines whether one or more of the modems in communication with the target server is inactive, such that one or more of the modems are not in communication with one or more of the subscribers;

wherein the target server is configured to apply a variable wait time when the one or more of the modems are not inactive, wherein a determined duration of the variable wait time is variably applied based at least in part on historical data and based at least in part on the utilization of the modems;

wherein the target server is configured to determine whether at least one of the modems is inactive after the variable wait time; and

wherein the target server is configured to send the message as an outgoing facsimile transmission to the target transceiver via the modem and the public switched telephone network.

14. The system of Claim 13, wherein the target server is further configured to store the message at the target server.

15.   The system of Claim 13, wherein the target server is further configured to reserve a modem for transmitting the message to the recipient.

16.   The system of Claim 13, wherein the target server is configured to queue the message for sending at a later time if there is no modem available for immediate sending.

17.-20 (Canceled).

21.   A method of communicating a message via a computer network, the method comprising:

receiving a message from a transceiver and a first server at a second server such that a second transceiver and the second server are located within a same local-toll area of a public switched telephone network and wherein the public switched telephone network is connected to the second server and to the second transceiver;

providing internet access services with the second server to a plurality of subscribers with a plurality of modems connected to the target server, wherein the modems receive a plurality of in-bound requests from the subscribers for access to the Internet, and wherein the modems are configured to communicate the message to recipients via the public switched telephone network;

receiving and storing the message at the second server;

determining whether one or more of the modems are inactive such that at least one of the modems is not in communication with one or more of the subscribers;

determining and applying a variable wait time when modems are not inactive, wherein the duration of the variable wait time is applied based at least in part on historical data and based at least in part on a number of the modems;

determining availability of the modems after the variable wait time; and

if one of the modems is available after the variable wait time, sending the message via an available one of the modems and the public switched telephone network to the second transceiver.

22.   The method of Claim 21, wherein receiving and storing includes processing the message according to a store-and-forward protocol.

23.   The method of Claim 21, further comprising reserving an available modem for sending the message.

24.   The method of Claim 21, further comprising queuing the transmission of the message, wherein queuing transmission of the message includes the variable wait time and wherein the variable wait time is further based upon at least one characteristic of the load upon the modems.

25.-31. (Canceled)